

REMARKS

The Official Action mailed March 1, 2004, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for Two Month Extension of Time*, which extends the shortened statutory period for response to August 1, 2004. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statement filed on August 22, 2003. A Request for Corrected PTO 1449 Form is submitted herewith and consideration of this Request is respectfully requested.

Claims 1-24 were pending in the present application prior to the above amendment. Independent claims 1, 5, 10, 16 and 20 have been amended to better recite the features of the present invention and to correct minor typographical errors. New dependent claims 25-29 have been added to recite additional protection to which the Applicants are entitled. Accordingly, claims 1-29 are now pending in the present application, of which claims 1, 5, 10, 16 and 20 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 1-24 under the doctrine of obviousness-type double patenting over claims 1-24 of U.S. Patent No. 6,618,105 to Yamazaki et al. The Applicants respectfully submit that the subject application is patentably distinct from the claims of the Yamazaki '105 patent.

As stated in MPEP § 804, under the heading "Obviousness-Type," in order to form an obviousness-type double patenting rejection, a claim in the present application must define an invention that is merely an obvious variation of an invention claimed in the prior art patent, and the claimed subject matter must not be patentably distinct from the subject matter claimed in a commonly owned patent. Also, the patent principally underlying the double patenting rejection is not considered prior art.

The Applicants respectfully traverse the obviousness-type double patenting rejection because the independent claims of the present invention, as amended, are

patentably distinct from the claims of Yamazaki '105. Specifically, independent claims 1, 5, 10, 16 and 20 have been amended to recite a black coating formed between a layer and a second substrate, which is supported in the specification, for example, at page 13, lines 21-23. The claims of Yamazaki '105 do not teach or suggest at least the above-referenced feature of the present invention.

Therefore, the Applicants respectfully submit that the subject application is patentably distinct from the claims of the Yamazaki '105 patent. Reconsideration of the obviousness-type double patenting rejection is requested.

The Official Action rejects claims 1-9 as anticipated by U.S. Patent No. 5,543,945 to Kimura et al. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present invention, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As noted above, independent claims 1 and 5 have been amended to recite a black coating formed between a layer and a second substrate. Kimura does not teach at least the above-referenced feature of the present invention, either explicitly or inherently.

Since Kimura does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects claims 10-15 as obvious based on the combination of U.S. Patent No. 5,003,356 to Wakai et al. and U.S. Patent No. 5,305,126 to Kobayashi et al. The Official Action rejects claims 20-24 as obvious based on the combination of Kimura and conventional liquid crystal electro-optical devices described in the Applicants' specification at page 7, lines 12-21 ("conventional art"). The Applicants

respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present invention, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. As noted above, independent claims 10 and 20 have been amended to recite a black coating formed between a layer and a second substrate. Wakai, Kobayashi, Kimura and the conventional art, either alone or in combination, do not teach or suggest at least the above-referenced features of the present invention.

Since Wakai, Kobayashi, Kimura and the conventional art do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New dependent claims 25-29 have been added to recite additional protection to which the Applicants are entitled. Specifically, new claims 25-29 recite black stripes comprising the black coating. For the reasons stated above and already of record, the Applicants respectfully submit that new claims 25-29 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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